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10/518,369	12/17/2004	Christoph Schwan	740105-108	8185
25570 7590 11/12/2008 ROBERT'S MLOTKOWSKI SAFRAN & COLE, P.C. Intellectual Property Department P.O. Box 10064 MCLEAN, VA 22102-8064				
EXAMINER				
PAINTER, BRANON C				
ART UNIT		PAPER NUMBER		
3633				
NOTIFICATION DATE		DELIVERY MODE		
11/12/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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dbeltran@rmsclaw.com

### Office Action Summary

**Application No.**

10/518,369

**Applicant(s)**

SCHWAN, CHRISTOPH

**Examiner**

BRANON C. PAINTER

**Art Unit**

3633

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-21 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 10, 12, 13 and 15-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Objections***

1. Claim 9 is objected to because of the following informalities:
  - a. Claim 9, "is provided with." For the purpose of this examination, the examiner presumes this should read "are provided with."
  - b. Appropriate correction is required for all preceding objections.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant claims that "a space defined between facing sides of said front and rear masonry walls" is "free of insulating materials." However, applicant provides no support for this claim in the specification. Instead, applicant shows a wall system containing both a reflection layer and an air space between the facing sides of the front and rear walls. The reflection layer is used to insulate the system, and air is known to have insulative

characteristics, as admitted by the applicant. Applicant's disclosed invention fails to meet the claim limitations.

4. Claims 10, 12-13, 15-16, and 20-21 are rejected under 35 U.S.C. 112, first paragraph, for depending from a claim that fails to meet the written description requirement.
5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 20-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. Claim 20 is rendered vague and indefinite by the phrase "vertical bars." It is unclear why the bars are labeled "vertical," as the bars shown in Fig. 1 of the application appear to extend horizontally along the width of the wall, rather than vertically along the height. For the purposes of this examination, the examiner presumes that a bar extending in any capacity vertically will meet the limitations of the claim.
8. Claim 21 recites the limitation "the static air chambers". There is insufficient antecedent basis for this limitation in the claim. For the purpose of this examination, the examiner presumes that this refers to the static air chambers of claim 20.

***Claim Rejections - 35 USC § 102***

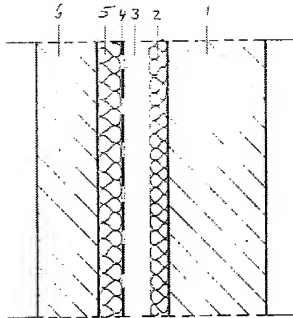
9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 9-14 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Saalfeld (English translation of DE 3,530,973 A1).
11. Regarding claim 9, Saalfeld discloses an exterior wall system having all of the applicant's claimed structure, including:
  - a. Rear (1, Fig. 1) and front (6) masonry walls.
  - b. Wherein elements of the front wall, only on the side facing the rear wall, are provided with a heat reflective layer (4).
  - c. Wherein a stationary air layer (3) is formed in a space defined between facing sides of said front and rear walls, said space being free of insulating materials (the space between 4 and 2 is free of insulation sheets). To the examiner's best understanding, applicant is attempting to claim that the space is without insulations sheets. The space described meets that limitation.
  - d. The examiner notes that applicant is not claiming that the entire space is free of insulating materials, only that some part of the space is free of them.

Fig. 1



Reproduced from Saalfeld

12. Regarding claim 17, Saalfeld discloses a construction element (6) provided with a layer of metal (4) which is reflective of heat radiation on their side facing the rear brickwork.
13. Regarding claims 10 and 18, Saalfeld discloses constructional elements of bricks ("masonry" 1 & 6).
14. Regarding claims 13 and 19, Saalfeld discloses construction elements of the front masonry wall coated in regions of their inner side with aluminum ("aluminum" 4).
15. Regarding claim 16, Saalfeld discloses construction elements of bricks ("masonry" 1 & 6) which only on their inner side are provided with a reflective coating (4).
  - a. The examiner notes that the masonry elements of Saalfeld are considered façade plates, since they form a façade, since bricks are essentially plates,

and since the claim provides no further structure precluding such an interpretation.

- b. The examiner further notes applicant's disclosure that various alternate construction elements could be used as would be appreciated by one skilled in the art and without departing from the scope of the invention (bricks, building blocks, and façade plates are equivalents: claims 10, 18).

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

18. Claim 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Saalfeld (English translation of DE 3,530,973 A1).

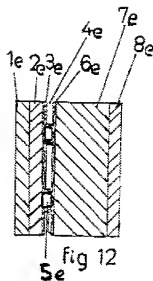
- a. Saalfeld discloses the claimed invention except for a front masonry wall with a thickness of more than 60mm. It would have been obvious to one having

ordinary skill in the art at the time the invention was made to use a front brickwork of this thickness, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *MPEP 2144.05*.

19. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saalfeld (English translation of DE 3,530,973 A1) in view of Kotrotsios (6,397,554).

- a. Saalfeld discloses an exterior wall system as set forth above, including a heat-reflective layer (4).
- b. Saalfeld does not expressly disclose a heat-reflective layer that is made of a vapor-deposited material.
- c. Kotrotsios discloses a vapor-deposited heat-reflective layer (3f, Fig.12; c. 4, 59-61).
- d. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to replace the heat-reflective layer of Saalfeld with the vapor-deposited heat-reflective layer taught by Kotrotsios, since the layers serve the same heat-reflective function and are known equivalents in the art.





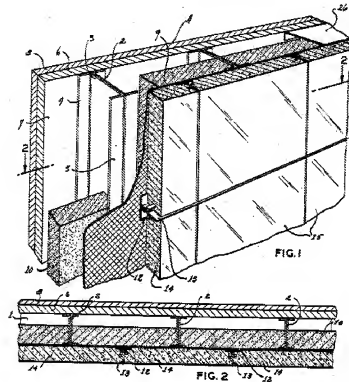
Reproduced from Kotrotsios

20. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saalfeld (English translation of DE 3,530,973 A1) in view of Huntley (2,856,766).

21. Regarding claim 20:

- a. Saalfeld discloses an exterior wall system as set forth above, including a static air space.
- b. Saalfeld does not expressly disclose static air chambers subdivided by vertical bars that bridge the space between the front and rear masonry walls.
- c. Huntley discloses vertical uprights (2, Figs. 1, 2) that bridge the space between front (6) and rear (10) walls and that subdivide the space between walls into static chambers.
- d. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify wall system of Saalfeld by adding vertical

bars to subdivide the chambers as taught by Huntley, in order to further limit the inter-chamber movement of air, resulting in greater thermal insulation.



Reproduced from Huntley

22. Regarding claim 21:

- a. Saalfeld/Huntley discloses the claimed invention except for a static air chamber whose thickness is 30mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a static air chamber of this thickness, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *MPEP* 2144.05.

***Response to Arguments***

23. Applicant's arguments filed 08/12/08 have been fully considered but they are not persuasive.
24. Applicant argues that the use of a metal layer in conventional construction "is impossible." However, the prior art clearly shows a metal layer used for insulative reflection as set forth above.
25. The examiner notes applicant's correct assumption that the decisions of other patent offices are not binding on the present examination of the instant application.
26. Applicant's arguments with respect to Glassgroup have been considered but are moot in view of the new ground(s) of rejection.
27. Applicant argues extensively that that the space between walls of the instant invention does not contain insulating materials. However, as noted above, applicant's space between walls does contain insulating materials. Furthermore, regardless of any structural differences between Saalfeld and the instant invention, Saalfeld does meet all the limitations of the new claim 9 as set forth in the new rejection above.

***Conclusion***

28. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

29. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANON C. PAINTER whose telephone number is (571)270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. C. P./  
Examiner, Art Unit 3633  
11/04/08  
/Basil Katcheves/  
Primary Examiner, Art Unit 3635